

CP/1724/16

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

REINOUT G. OUSSOREN  
JACK T. CLEMENTS

Ser. No. 09/430,063

Filed: 10/29/99

UNITARY FILTER CARTRIDGE



Examiner: Minh-Chau Pham

Art Unit: 1724

Atty. Docket No. BHAG.68900

PETITION TO THE COMMISSIONER

RECEIVED

AUG 30 2001

OFFICE OF PETITIONS

Asst. Commissioner for Patents  
Washington, D.C. 20231

Dear Sir:

COMES NOW Applicant in the subject application and, pursuant to the provisions of 37 C.F.R. § 1.181, petitions the Commissioner to expunge from the Final Office Action dated May 22, 2001 an infringement opinion rendered by the Patent Examiner. More specifically, the Commissioner is requested to expunge, in its entirety, the sentence reading "Therefore, the Brunner filter is NOT an infringement of Applicants' earlier Patent 5,632.791" which appears at the bottom of Page 5 of the Final Office Action attached hereto as Exhibit A.

The Commissioner is advised that there is pending litigation in the United States District Court for the Western District of Missouri styled BHA Group, Inc. v. Midwesco Filter Resources, Inc., Civil Action No. 4:97cv00796 which involves whether or not a filter having a construction very similar to that shown in Fig. 5 of the Brunner reference infringes United States Reissue Letters Patent No. RE37,163 (formerly U.S. Letters Patent No. 5,632,791).

The statement of the Examiner in this pending application which the Applicant seeks to expunge is an erroneous, gratuitous opinion which the Examiner is not authorized by law to render, and which goes beyond the duties of a patent examiner. The opinion is likely to affect the

rights of the respective parties in the referenced litigation and, moreover, neither party to the litigation has the opportunity to cross-examine the Examiner as to the basis of her opinion.

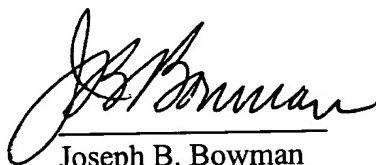
A careful examination of the M.P.E.P. reveals no authority for any examiner to render infringement opinions in connection with the examination of patent applications. The offending language used by the examiner in this case is nowhere approved in Chapter 700 of the M.P.E.P. It is believed that the only time that Chapter 700 of the M.P.E.P. even mentions infringement is in connection with a petition to make special (§ 708.02) in which there is absolutely no provision that the examiner can challenge a supporting statement of actual infringement made by the applicant, assignee or attorney/agent registered to practice before the PTO.

Additionally, even though the Examiner chose to place the gratuitous infringement opinion in the Office Action without authority and far beyond the scope of the duties of examiners in reviewing pending patent applications, the Examiner's opinion is legally erroneous. The language of Claim 1 of the Patent RE37,163 (formerly U.S. Patent No. 5,632,791) can be read directly on the Brunner filter construction shown in Figs. 1 and 5 of the Brunner U.S. 5,964,909 in order to establish direct literal infringement. Moreover, in rendering the erroneous and gratuitous opinion, the Examiner had no opportunity to consider any of the facts and circumstances present in the pending litigation which is referenced to support a finding of patent infringement under the Doctrine of Equivalents.

Although Applicant has contemporaneously filed a Notice of Appeal challenging the merits of the Examiner's Final Office Action in the subject application, it is believed necessary, for the reasons set forth herein, for the Commissioner to expunge from this record, the infringement opinion of the Examiner. Favorable action on this Petition is requested.

Applicant submits herewith a check in the amount of \$130.00 for the filing of this Petition; however, the Commissioner is authorized to charge any additional fee which may be required, or credit any overpayment, to Deposit Account No. 19-2112. A duplicate copy of this letter is enclosed.

Respectfully submitted,



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